TC 1641

Dkt. 67473/RSM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Zhibo GAN

Serial No. : 10/088,532 Art Unit: 1641

Filed : April 3, 2002 Examiner: G. Gabel

For : NON-SEPARATION HETEROGENOUS ASSAY FOR BIOLOGICAL SUBSTANCES

1185 Avenue of the Americas
New York, New York 10036
December 28, 2005

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

COMMUNICATION IN RESPONSE TO A DECEMBER 1, 2005 OFFICE ACTION

This Communication is submitted in response to the December 1, 2005 Office Action issued in connection with the above-identified application. A response to the December 1, 2005 Office Action is due January 1, 2006. Accordingly, this Amendment is being submitted timely.

The Office Action required restriction under 35 U.S.C. §121 and §372 to one of the following allegedly single inventions:

Group I - Claims 1-11, drawn to competitive binding assay method;

Group II - Claims 12-24, drawn to enzyme assay method; or

Group III - Claim 25, drawn to enzyme inhibition assay method.

According to Sections 1 and 2 of the Office Action the allegedly separate inventions of Groups I, II, III do not relate to a single general inventive concept under PCT Rules 13.1 and 13.2 because the allegedly single inventions lack the same or corresponding special technical features. The Office Action also required an election of the invention to be examined even though the requirement be traversed.

More specifically, according to the Office Action: (1) Group I relates to a labeled Reactant 3 and unknown amount of Reactant 2 competitively binding to a Reactant 1 coated in a vessel, to obtain a signal that provides a direct proportional relationship between the label signal and the concentration of Reactant 2; (2) Group II relates to bioactivity of Reactant 2 measured by its hydrolysis of the substrate labeled Reactant 1 wherein a change of signal obtained therefrom provides a direct proportional relationship to the amount of bioactivity of Reactant 2; and (3) Group III relates to bioactivity of Reactant 2 measured by inhibition of an unknown amount of an inhibitor to its hydrolysis of the substrate of labeled Reactant 1 wherein a change of label signal obtained in the interaction between the three components provides an inverse proportional relationship to the amount of the inhibitor.

In response to this election requirement, applicant hereby elects, with traverse, to prosecute the alleged separate invention of Group I, that is, claims 1-11.

However, applicants respectfully request that the restriction requirement be reconsidered and withdrawn. Under 35 U.S.C. §121, restriction may be required if two or more independent and distinct

inventions are claimed in one application. However, under M.P.E.P. §803, an application must be examined on the merits, even though it includes claims to distinct inventions, if search and examination of an application can be made without serious burden.

Applicant maintains that it would not be a serious burden on the Examiner if restriction is not required because a search of the related art for the elements of any one of the three Groups are likely to identify the art relating to the other Groups. More specifically, in this application, since all the Groups share certain common elements, for example, coating vessels with reactants and measuring/detecting the changes in a label signal linked to that or another reactant, art identified in the searches of one Group is likely to identify the art for elements unique to the other Groups, for example, which reactant is linked to the label signal. Accordingly, applicant respectfully submits that there is no serious burden on the Examiner to search for all three allegedly single inventions. Thus according to M.P.E.P. §803, the Examiner should examine all three allegedly single inventions on the merits.

In view of the preceding remarks, the applicant respectfully requests that the Examiner reconsider and withdraw the requirement for restriction under 35 U.S.C. §121 and §372.

Applicant looks forward to a favorable action on the merits.

If a telephone conference would be of assistance in advancing prosecution of the subject application, applicant's undersigned attorney invites the Examiner to telephone him at the number

provided.

No fee is deemed necessary in connection with this Communication. However, if any such fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,

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I hereby certify that this paper is being deposited this date with the U.S. Postal Service as first class mail addressed to:
Commissioner for Patents
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28 Dec 2005

Richard S. Milner
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Date